



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : ZHI *et al.*
Serial No. : 10/590,119
Filed : June 11, 2007
Cust. No. : 13565
Title : ANDROGEN RECEPTOR MODULATOR COMPOUNDS AND METHODS

Art Unit : 1625
Examiner : Nizal S. Chandrakumar
Conf. No. : 1033

MAIL STOP PETITIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION PURSUANT TO 37 C.F.R. §1.181 FOR RECONSIDERATION AND
REMOVAL OF THE FINALITY OF THE OFFICE ACTION**

Dear Sir:

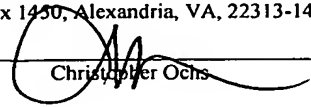
Applicant hereby submits a Petition pursuant to 37 C.F.R. §1.181 for reconsideration and removal of the finality of the Office Action, mailed April 15, 2011, in connection with the above-captioned application. This Petition is filed within two months of the mailing of the final rejection.

Remarks begin on page 2 of this paper.

A Change of Correspondence Address Application accompanies this Petition.

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I hereby certify that this paper is being deposited with the United States Postal "Express Mail Post Office to Addressee" Service under 37 CFR §1.10 on the date indicated above and is addressed to: Mail Stop Petitions, Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.


Christopher Ochs

REMARKS

Any fees that may be due in connection with the filing of this paper or with this application should be charged to Deposit Account No. 50-0911. If a Petition for Extension of Time is needed, this paper is to be considered such Petition.

It respectfully is submitted that the Office Action, mailed April 15, 2011, which was made Final, introduces a new ground of rejection of claims 1-25, 27-35, 62-68 and 78 under 35 U.S.C. §112, second paragraph, which was not necessitated by amendment and that could have been applied in a previous Office Action. Therefore, the Action should not have been made Final.

Rejection of claims 1-25, 27-35, 62-68 and 78 under 35 U.S.C. § 112, 2nd Paragraph

In the instant Office Action, the Examiner newly has rejected claims 1-25, 27-35, 62-68 and 78 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter because the recitation “pharmaceutically acceptable ester or amide thereof” is considered “vague and indefinite.”

Applicant respectfully submits that, to the extent that this ground of rejection is proper, it could have been applied to claims 1-25, 27-35, 62-68 and 78 in the previous Office Action.

Claims 1-25, 27-29, 62-68 and 78

Claim 1 was amended in the previous Response, mailed February 14, 2011, to eliminate hydrogen and alkyl as alternatives in the definition of R^2 and to correct an error in the definition of R^9 by including the selections COR^A and CO_2R^A , which are recited in original claim 2. Claim 1 as previously pending recites “or a pharmaceutically acceptable salt, ester, or amide thereof.” Original claim 1 recites “or a pharmaceutically acceptable salt, ester, amide or prodrug thereof.” Claims 2-25, 27-35, 62-68 and 78 ultimately depend from claim 1 and include every limitation thereof.

Thus, to the extent this rejection is pertinent to pending claims 1-25, 27-35, 62-68 and 78, previously pending claims 1-25, 27-35, 62-68 and 78, which included the recitation “or a pharmaceutically acceptable salt, ester, or amide thereof,” could have been so-rejected in the last Office Action. Therefore, the new ground of rejection is not necessitated by the amendment of claim 1 in the previous Response.

Claims 30-35

Claim 30 was amended in the previous Response, mailed February 14, 2011, to be an independent claim and to recite the limitations of claim 1. Claim 30 as previously pending depended from claim 1 and included every limitation thereof. Thus, claim 30 as previously

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Petition for Removal of Premature Final Rejection

pending included the recitation "or a pharmaceutically acceptable salt, ester, or amide thereof" because it depended from claim 1, which as previously pending recites "or a pharmaceutically acceptable salt, ester, or amide thereof." Claims 31-35 ultimately depend from claim 30 and include every limitation thereof.

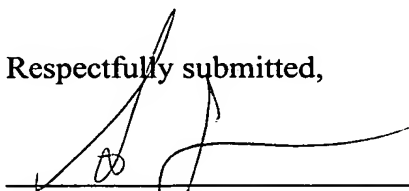
Thus, to the extent this rejection is pertinent to pending claims 30-35, previously pending claims 30-35, which included the recitation "or a pharmaceutically acceptable salt, ester, or amide thereof" because they ultimately depended from claim 1, could have been so-rejected in the last Office Action. Therefore, the new ground of rejection is not necessitated by the amendment of claim 30 in the previous Response.

Failure to withdraw the finality of the Office Action denies the Applicant the right to amend the claims, if needed, and/or provide arguments to overcome this new rejection. Therefore, since the newly recited rejection of claims 1-25, 27-35, 62-68 and 78 under 35 U.S.C. §112, second paragraph was not necessitated by amendment and could have been raised in a previous Office Action, the finality of the Office Action is improper.

* * *

In light of the above remarks, removal of the finality of the Office Action respectfully is requested.

Respectfully submitted,



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